



Attorney Docket No. P-23,090-B USA

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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Bruce K. Redding, Jr., et al.**

Examiner: **D. Becker**

Application No. **09/360,262**

Group Art Unit: **1761**

Filed: **April 24, 1998**

Attorney Docket No.: **P-23,090-B USA**

For: **Process and Apparatus for Producing Dietary Fiber Products**

CERTIFICATE OF MAILING

I hereby certify that this correspondence, along with any papers indicated as being enclosed, are being deposited as First Class Mail in an envelope addressed to: **Box AF**, Commissioner for Patents, Washington, D.C. 20231 on November 25, 2002.


Patricia M. Frisoli

Box AF
Commissioner for Patents
Washington, D.C. 20231

SUPPLEMENTAL APPEAL BRIEF

Sir:

This Supplemental Appeal Brief is submitted pursuant to 37 C.F.R. § 1.193 in connection with the applicants' request for reinstatement of the appeal submitted herewith in response to the Office Action, mailed August 23, 2002 (the "Office Action"), having a shortened statutory period for response set to expire on November 25, 2002 (November 23, 2002 falling on a Saturday).

In accordance with 37 C.F.R. § 1.192(c), the applicants incorporate herein by reference the statements regarding real party in interest and related appeals and interferences, the status of claims and amendments, the summary of invention, and the grouping of claims set forth in the Appeal Brief filed on June 17, 2002 (the "Appeal Brief"). While the arguments presented herein are relevant only to the new ground of rejection raised in the Office Action, the applicants continue to assert as relevant all of the issues and arguments presented in the Appeal Brief.

STATEMENT REGARDING ISSUES PRESENTED FOR REVIEW

The issues presented for review are:

1. Whether the pending claims are patentable over U.S. Patent No. 5,455,342 to Redding Jr. in view of *The Polymer Handbook*, and in view of Fennema; and
2. Whether the pending claims are novel in view of U.S. Patent No. 5,455,342 to Redding Jr.

ARGUMENT

A. Procedural Background

In a Final Office Action, mailed October 19, 2001 (the "Final Office Action"), claims 1, 3-4, 6-7, 9, 15, and 18 were finally rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 5,455,342 to Redding et al. (the "Redding patent"). Claims 2, 5, 8-10, 12-13 and 16 were finally rejected under 35 U.S.C. § 103 based on the Redding patent in view of *The Polymer Handbook*, and claims 11 and 17 were finally rejected under § 103

based on the Redding patent in view of the Fennema reference. In addition, claims 10 and 11 (and claims 15-17 depending therefrom) were rejected under 35 U.S.C. § 112, second paragraph.

On January 16, 2002, the applicants filed a Response After Final (the "Response") in which they made certain amendments to claims 1, 10 and 11, and cancelled claim 2. As was noted in the Response After Final, claim 2 was not identified in the Final Office Action as being rejected under § 102(e). It was thus recognized that the modification of the particular properties identified in claim 2 is not anticipated by the Redding patent. Accordingly, the applicants amended claim 1 to specify the particular properties recited in claim 2 (i.e., identifying the modified properties as the water and oil holding capacities of the dietary fiber). In view of this amendment, the applicants asserted that the rejection under § 102(e) had been overcome. The applicants also presented arguments in favor of patentability of all of the claims over the combinations of the Redding patent with the two secondary references which served as the bases for the § 103 rejections.

In an Advisory Action, mailed February 25, 2002, (the "Advisory Action"), the Examiner noted that the amendments offered in the Response had been entered and that, in view of such amendments, the rejection under 35 U.S.C. § 112, second paragraph, had been overcome. The rejections under 35 U.S.C. § 103, however, were maintained "for the reasons of record in [the Final Office Action] with regards to the 103(a) rejections by Redding Jr. in view of The Polymer Handbook and Fennema respectively." *See* Advisory Action at p. 2. The applicants note that the Advisory Action was silent as to whether the rejection under 35 U.S.C. § 102(e) made in the Final Office Action had been withdrawn in view of the

applicants' most recent amendment to claim 1, but such a conclusion is implied by the wording of the statement of reasons set forth in the Advisory Action.

On June 17, 2002, the applicants filed the Appeal Brief within the time specified by the filing of the Notice of Appeal. In the Appeal Brief, the applicants noted that claim 2 was not identified in the Final Office Action as being rejected under § 102(e). Thus, while it was the applicants' position that only the § 103(a) rejections were pending, the applicants nonetheless restated the arguments for patentability with respect to both § 102(e) and § 103(a).

In the Office Action, mailed August 23, 2002, the Examiner reopened prosecution due to an asserted erroneous listing of claim 2 (now cancelled) as rejected under 35 U.S.C. § 103(a) instead of 35 U.S.C. § 102(e). The effect of this shift in the Examiner's position regarding cancelled claim 2 is that pending claims 1, 3-4, 6-7, 9, 15 and 18 now stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Redding patent rather than under 103(a) based on the Redding patent in view of The Polymer Handbook and the Fennema reference. Moreover, claims 5, 8, 12 and 13 now stand rejected under 35 U.S.C. § 103(a) based on the Redding patent rather than the Redding patent in view of The Polymer Handbook.

B. Supplemental Arguments in Favor of Patentability

The applicants incorporate herein all of the arguments with respect to patentability set forth in the Appeal Brief as though set forth fully herein. With regard to those arguments, the applicants reiterate that neither the properties, the materials nor the specific results of the claimed method are in any way contemplated by the Redding patent. Moreover, the

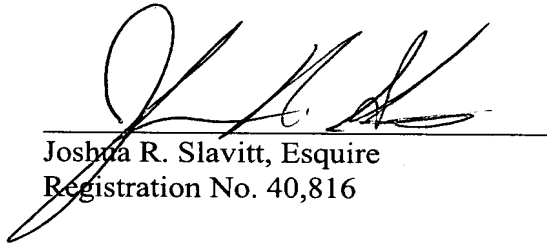
Examiner has incorrectly accorded the preamble of claim 1 no patentable weight despite the fact that the body of claim 1 depends on the preamble insofar as the antecedent basis for "modified fiber material" is found in the modification of water and oil holding capacities recited in the preamble. In view of the dependency of the term "modified fiber material" on the preamble of claim 1, the Examiner's reliance on *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478 (CCPA 1951) is misplaced.

CONCLUSION

In view of the above remarks, the present application is believed to be in condition for allowance, and a reversal the Examiner's outstanding rejections is respectfully requested.

Respectfully submitted,

Dated: November 25, 2002



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